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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,049	07/18/2000	Mark D. Yandell	CL000735	9668

7590 02/10/2003

Celera Genomics  
Robert A Millman Patent Director  
45 West Gude Drive C2-4#20  
Rockville, MD 20850

EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 02/10/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/619,049

Applicant(s)

YANDELL, MARK D.

Examiner

Suryaprabha Chunduru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,6,8,15 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,6,8 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Applicants' response to the office action (Paper No. 11) filed on December 3, 2002 has been entered and considered.

**Response to arguments**

3. Applicants' response to the office action (Paper No. 11) is fully considered and found persuasive in part.

3. With respect to the rejection made in the previous office action under provisional obviousness - type double patenting, Applicant's arguments with respect to claims 4, 6, 8, and 22-26 are considered but are found not persuasive because, Applicants indicated that they would delete the SEQ ID Nos. 85-87 of the co-pending application, but did not delete said SEQ ID Nos. Thus the rejection will be maintained until the deletion of said SEQ ID Nos. in the co-pending application.

4. With respect to the rejection under 35 U.S.C. 102 (f) and 102 (e)/103(a) made in the previous office action, Applicants arguments are fully considered. Examiner relays on the Applicants' arguments regarding priority of the claimed SEQ ID Nos. in any of the provisional applications of 09/614,893 and 09/614, 150. The rejections under 102 (f) and 102 (e)/103(a) are withdrawn herein in view of the Applicants' arguments.

5. With reference to the rejection made in the previous office action under 35 USC 101 Utility, Applicants' arguments are fully considered and found not persuasive. Applicants argue that the claimed invention has utility in the commercial market and traverse the rejection with the citations from case laws especially the case Juicy Whip v Orange Bang (Fed. Cir. 1999) and indicate that the USPTO guidelines for utility standards is too high. Applicants further argue that

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use of the claimed sequences (if made public by granting a patent) would shorten the process for researchers and aid in discovering other novel uses for the present *Drosophila* protein-encoding nucleic acids. Applicant fails to identify how this is specific to the particular sequence claimed or substantial in any particular way.

Applicants arguments are fully considered, and found not persuasive. Applicants' argue that case law, specifically, *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 51 U.S.P.Q.2d 1700 (Fed. Cir. 1999) along with the other cited cases supports the position that the utility threshold is not high. These are Federal circuit cases. In a conflict with Supreme Court precedent, the Supreme Court case is authoritative as a matter of black letter law. In *Brenner v. Manson*, 148 U.S.P.Q. 689 (1966), a novel compound which was structurally analogous to other compounds which were known to possess anti-tumor activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 U.S.C. §101, which requires that an invention must have either an immediately apparent or fully disclosed "real world" utility. The court held that:

The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility. . . . [u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field. . . . a patent is not a hunting license. . . .[i]t is not a reward for the search, but compensation for its successful conclusion.

The instant claims are drawn to polynucleotides encoding a protein, which has no identified activity. The function of this gene and its resulting protein are as yet undetermined with no known function or biological significance. Until some actual and specific significance can be attributed to the protein identified in the specification, or the gene encoding it, one of ordinary skill in the art would be required to perform additional experimentation in order to determine how to use the claimed invention. Thus, there was no immediately apparent or “real world” utility as of the filing date directly consistent with *Brenner v. Manson*.

Further, the cases cited by Applicant can be distinguished. In *Juicy Whip*, the lack of utility argument which was reversed by the Federal Circuit was not predicated on the basis that the invention in fact lacked utility, but rather that the invention was deceptive. Here, the invention itself simply lacks any substantial or specific utility. Therefore, the rejection is maintained.

### ***Conclusion***

No claims are allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Suryaprabha Chunduru  
February 6, 2003

  
JEFFREY FREDMAN  
PRIMARY EXAMINER